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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,031	04/27/2001	Rosa Uy	56629USA6A.002	1942

7590

09/16/2002

Attention: John A. Burtis
Office of Intellectual Property Counsel
3M Innovative Properties Company
P. O. Box 33427
St. Paul, MN 55133-3427

EXAMINER

BERMAN, SUSAN W

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 09/16/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,031

Applicant(s)

UY ET AL.

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for pressure sensitive microemulsions as defined in claim 1, does not reasonably provide enablement for other kinds of microemulsions having pressure sensitive adhesive properties. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. See claim 1 and pages 6-14 in the specification .

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In each of claims 9 and 15 it is not clear whether applicant intends to claim a method of forming a polymerized PSA or of forming a microemulsion psa composition. Since step (4) in claim 9 and step (9) in claim 15 recite irradiating the microemulsion, it appears that lines 1-2 should read “method of forming a polymerized microemulsion pressure sensitive adhesive”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

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- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Tran et al (6,103,316).

Tran et al disclose a process for making electron beam polymerized emulsion-based acrylate pressure sensitive adhesives. Tran et al disclose that water-soluble suspending agents such as polyacrylic acid and polyvinyl alcohol can be used to stabilize the precursor emulsions and that acrylic polymers can be added (column 8, lines 48-58, and column 10, lines 58-65). The method for making the emulsions is taught in column 11, line 63, to column 12, line 52, and shown in the Examples. Tran et al teach mixing under high shear conditions until the material forms droplets less than 1 micrometer in diameter and are homogeneous (column 12, lines 13-17). A mixture of acrylate monomers, such as isooctyl acrylate and acrylic acid, is used in the examples. Although no initiators are present in the examples Tran clearly teaches that initiators, as well as polyacrylic polymers, may be included in the precursor mixture (column 10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coughlan et al (4,564,010) in combination with Dietz et al (5,670,557). Coughlan et al disclose pressure sensitive adhesive films for medical use comprising a polyacrylic latex and an ester resin in combination with a

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thickener. The polyacrylic latex can be a high solids aqueous acrylic emulsion (column 3, lines 19-50). The thickener can be an acrylic polymer (column 3, lines 57-64). Dietz et al teach polymerized microemulsion pressure sensitive adhesive compositions for use in biomedical articles. Dietz et al teach a method for making the microemulsion in columns 19-23, including irradiating the microemulsion to form a PSA in contact with a substrate (column 23, lines 1-18). Dietz et al teach that the polymerized emulsion PSA's have easily tailored PSA properties, such as adhesion and peel strength, to meet the adhesive requirements to mammalian skin in the field of health care. See column 24 and the discussions of biomedical electrodes, medical skin coverings and pharmaceutical delivery devices discussed in columns 25-33.

With respect to claims 1-8, It would have been obvious to one skilled in the art to employ the microemulsion taught by Dietz et al as the polyacrylic latex in the adhesive film taught by Coughlan et al. Coughlan et al teach that a number of commercially available polyacrylic latex products can be used, such as a suspension copolymer containing ethylhexylacrylate and acrylamide or aqueous acrylic emulsions, thus suggesting the combination of hydrophobic and hydrophilic monomers and the use of aqueous emulsions. Dietz et al provide motivation to employ the disclosed microemulsions by teaching that the polymerized emulsion PSA's have easily tailored PSA properties, such as adhesion and peel strength.

With respect to claims 9-16, it would have been obvious to one skilled in the art to employ the method of forming a polymerized microemulsion taught by Dietz et al employing a composition comprising a microemulsion composition and thickener as taught by combination of the teachings of Dietz et al and Coughlan et al. Coughlan et al and Dietz et al provide motivation to provide a composition comprising a microemulsion and a thickener to provide pressure sensitive adhesives for medical use. Dietz et al teach that the disclosed microemulsion compositions can be polymerized on a substrate by irradiation.

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Conclusion

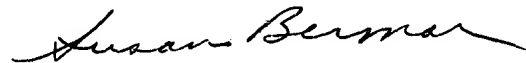
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Powell (4,618,390), Coopriders et al (5,571,617), Sablowsky et al (5,186,938), Mori et al (4,110,290), Fox et al (5,868,136) and Heard et al (6,115,625) are cited as art of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman

Primary Examiner

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SB
September 12, 2002